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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/488,769	01/21/2000	Pierre Sabatier	160383.90121	4877

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EXAMINER

LIN, KENNY S

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 12/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/488,769

Applicant(s)

SABATIER ET AL.

Examiner

Kenny Lin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Claims 1-5 are presented for examination.
2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The current title is imprecise. Suggested title "Process for establishing computer network communication using an incorporated message".
3. It is noted that the present application does not contain line numbers in the specification and claims. The preferred format for the claims is to number each line of every claim, with each claim beginning with line 1. For ease of reference by both the Examiner and Applicant all future correspondence should include the recommended line numbering.

### **Specification**

4. Applicant is reminded of the proper language and format for an abstract of the disclosure. The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because it (1) repeat information given in the title; (2) is not limited to a single paragraph; (3) does not describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details; (4); the phrase "Single figure" on the very bottom should not be place on the abstract page. Correction is required. See MPEP § 608.01(b).

5. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

#### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or  
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.

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(2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.

(f) BRIEF SUMMARY OF THE INVENTION.

(g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).

(h) DETAILED DESCRIPTION OF THE INVENTION.

(i) CLAIM OR CLAIMS (commencing on a separate sheet).

(j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).

(k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

6. The disclosure is objected to because of the following informalities: (1) Pages 3-4 and 6 have hole punched through; (2) small fonts made it hard to read; (3) the submitted copy of the disclosure is not clear and contains missing characters due to the process of faxing; and (4) Background of the invention, Brief Summary of the invention, Brief description of the drawing and Detailed description of the invention should be placed in sections as required by the arrangement of the specifications. See 37 CFR 1.77(b). A substitute specification is required because the current pages are illegible. The applicants are required to submit legible pages preferably in typed, double spaced form. The substitute specification filed must be accompanied by a statement that it contains no new matter. Such statement must be a verified statement if made by a person not registered to practice before the Office. The applicants also required to submit a marked-up copy of the original specification showing additions and deletions (see M.P.E.P. § 608.01(q)).

7. Claims 1-5 are objected to because of the following informalities: Characters in parentheses are not reference number (claim 1, IP31, XX, YY and IP1, claim 5, N1).

Appropriate correction is required.

### **Claim Rejections - 35 USC § 112**

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. The following claim language lack proper antecedence basis:

- i. Calling devices – claim 1 (i.e. since the calling devices refer to the two devices in line 2, they should be in one consistent name, applicant is suggest to change “two devices” in line 2 to “two calling devices” so to provide better antecedence basis);
- ii. The latter – claim 3 (i.e. change “the latter” to “second calling device”).
- iii. It – claims 1 and 3 (the use of the word “it” can cause confusion in interpretation. The words “it” in line 6 and line 10 of claim 1 refer to two different things. Applicant is suggested to replace all of the “it” with what is actually referring. For example, change the “it” in line 6 of claim 1 to “second calling device”).

- b. The following language renders claims indefinite:

- i. The improper use of “first” and “second” which in the claim language referring to two different types of network (computer network and telephone network) causes confusion in referencing them. (since the two

networks are of different types, there is no need to distinguish them by using “first” and “second”. Applicant is suggested to change the phrases to “said computer network” and “said telephone network” remove all current usage of “first” and “second”).

- ii. Applicant is suggested to use “first” and “second” in referring the two calling devices since they are of the same thing. The overuse of the terms “one of the two” and “the other” and “it” to refer to a particular device renders the claims indefinite.
- iii. The use of the phrase “the calling device calls the other device first of all” in claim 2 contains grammar errors. Applicant is suggested to replace the phrase with “the first calling device first calls the second device”

### **Claim Rejections - 35 USC § 103**

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ng et al, U.S. Patent 6,424,647, in view of Szviatovszki et al, U.S. Patent 6,470,010.

12. As per claim 1, Ng et al taught the invention substantially as claimed including a process for establishing a computer network communication, of the Internet type, between two calling devices (col.1, lines 61 to col.2, line 4) and a telephone network in which:

- a. The first calling device calls the second calling device on the telephone network to invite the second device into the communication (col.7, lines 42-48);
- b. The first calling device connects itself to the computer network (col.7, lines 48-56, 60-65); and
- c. The second device connects itself to the computer network and establishes the communication (col.7, lines 48-67, col.8, lines 1-6, 10-13).

13. Ng et al did not specifically teach to give the second device the reference of a message accessible on the computer network and the second device accesses the message to obtain the address to establish the communication. However, Ng et al did taught to establish communication when identifiers of the two devices are matched (col.8, lines 1-6). Szviatovszki et al taught to incorporate address into messages in order to establish communications (col.4, lines 33-51, col.5, lines 11-25). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Ng et al and Szviatovszki et al because Szviatovszki et al's teaching of incorporating address, identification and network service number into message would properly store/keep recorder of the caller's routing information in Ng et al's computer network communication establishing process.



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14. Furthermore, although Ng et al did not specifically teach to give the second device the reference of a message accessible on the computer network and the second device accesses the message to obtain the address to establish the communication. It is well known in the art to send information through e-mail to the other. One seeks to establish network communication would have been motivated to send his/her computer routing information (IP address, work station number, personal identifier...etc.) using an e-mail message, hence, when the receiver connects to a computer network and upon receiving the information contained in the e-mail message could use the information to establish a computer network communication with the caller. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Ng et al and use of e-mail messages to inform the receiver his/her IP-address or identifier.

15. As per claim 2, Ng et al and Szviovski et al taught the invention substantially as claimed in claim 1. Ng et al further taught that the first calling device calls the second device on the telephone network prior to connection to the computer network (col.7, lines 42-45, fig.3).

16. As per claim 3, Ng et al and Szviovski et al taught the invention substantially as claimed in claim 1. Ng et al further taught that when the first calling device calling the second device via telephone network, sends the second device a secret code word, which the latter subsequently retransmits, via the computer network to the first calling device so that the latter may agree to establish communication (col.7, lines 60-67, col.8, lines 1-6, col.9, line 57 to col.10, line 14).

17. As per claim 4, Ng et al and Szviovski et al taught the invention substantially as claimed in claim 1. Szviovski et al further taught to exchange signals verifying their compatibility for communication across the computer network (col.2, lines 60-67).

18. As per claim 5, Ng et al and Szviovski et al taught the invention substantially as claimed in claim 4. Szviovski et al further taught that the signals contain an identifier of the first calling device (col.5, lines 35-43, 46-50).

### **Conclusion**

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Wiener et al, U.S. Patent 6,324,264, disclosed method for establishing a communication call.

Bauer et al, U.S. Patent 6,169,796, disclosed call rerouting.

Vaziri et al, U.S. Patent 6,377,570, disclosed Internet switch box for Internet telephony.

Bruno et al, U.S. Patent 6,356,533, disclosed communication mode switching.

20. A shortened statutory period for reply to this Office action is set to expire THREE MONTHS from the mailing date of this action.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenny Lin whose telephone number is (703)305-0438. The examiner can normally be reached on 8 AM to 5 PM Tuesday to Friday and every other Monday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An can be reached on (703)305-9678. Additionally, the fax numbers for Group 2100 are as follows:

Official Responses: (703) 746-7239

After Final Responses: (703) 746-7238

Draft Responses: (703) 746-7240

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-5140.

ksl  
December 2, 2002



MENG-AL T. AN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100